

## REMARKS

Reexamination and reconsideration of this application is respectfully requested in light of the proposed amendments to claims 1 and the following remarks.

Claims 1-21 are pending in this application. No new matter has been added to the application.

Applicant again further notes the Examiner's acknowledgment of Applicant's claim for foreign priority under 35 U.S.C. § 119 and receipt of the certified priority document as well as the Examiner's acceptance of the formal drawings filed on August 26, 2003.

Applicant appreciates the courtesy of the telephone interview granted by the Examiner on June 11, 2008, at which the Hirano reference was discussed. After considering Applicant's arguments regarding Hirano, the Examiner agreed to reconsider the rejection of claims 10, 11 and 17. The Examiner also indicated the phrase "at least one particular driving unit" was indefinite and that if we changed the phrase to delete "particular," the claims could be in allowable condition. The Examiner indicated that the allowance of the claims would be predicated on a further updated search of the prior art. Accordingly, it is proposed to amend claims 1-9, 11-16 and 18-21 to delete "particular" and to add the phrase "at least one" where appropriate. It is respectfully requested that the amendment be entered.

### Rejection Under 35 U.S.C. § 102

Claim 21 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Ishida et al. (U.S. Patent No. 6,639,625). The claim recites a driving controller for controlling driving of a plurality of driving units physically connected with one another wherein at least one driving unit includes a driving member frictionally engaged with a driven member. The claimed structure

includes a controlling circuit that controls the driving circuit to drive another driving unit when the detecting circuit detects that the position of the driven member engaged with the driving member of the at least one driving unit has not changed at a predetermined time. The Examiner acknowledges that this feature is not disclosed or suggested by Ishida et al.

In the rejection of claims 1-9, 12-16 and 18-20, the rejection states that Ishida et al. "fails to teach that the controlling circuit controls the driving circuit to drive the another driving unit when the detecting circuit detects that the position of the driven member engaged with the driving member of the [at least one] driving unit has not changed at a predetermined time." "A rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference." *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994); see *Karsten Manufacturing Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383 (Fed. Cir. 2001) ("Invalidity on the ground of 'anticipation' requires lack of novelty of the invention as claimed. . . . that is, all of the elements and limitations of the claim must be shown in a single prior reference, arranged as in the claim."). In view of the fact that the function of the controlling circuit is not disclosed in Ishida et al., a *prima facie* case of anticipation has not been established. Accordingly, it is respectfully requested that the rejection of claim 21 as being anticipated by Ishida et al. be reconsidered and withdrawn.

#### **Rejection Under 35 U.S.C. § 103 over Ishida and Hirano**

Claims 1-9, 12-16 and 18-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishida et al. (U.S. Patent No. 6,639,625) and Hirano et al. (U.S. Patent No. 5,740,472). Independent claims 1 and 13 require that controlling circuit that controls the driving circuit to drive another driving unit when the detecting circuit detects that the position of the

driven member engaged with the driving member of the at least one driving unit has not changed at a predetermined time. The Examiner acknowledges that this feature is not disclosed or suggested by Ishida et al. It is also not disclosed or suggested by Hirano.

The rejection relies on the abstract, col. 2, lines 11-30, col. 3, lines 9-28, col. 4, lines 19-40 and col. 16, lines 49 et seq. of Hirano as teaching the use of a control circuit to control a driving circuit to drive a driving unit when a detecting circuit detects that the position of a driven member attached to the driving member of another driving unit has not changed over a predetermined period of time. Hirano is directed to a vibration reduction device. The system described by Hirano includes setting a predetermined period of time, but it does not disclose a detection circuit that detects when a driven member has not changed over a period of time.

Independent claim 18 requires (i) detecting whether the position of a driven member has changed at a predetermined time and (ii) driving a driving unit when a detecting circuit detects that the position of a driven member engaged with the driving member of the another driving unit has not changed at a predetermined time. The Examiner concedes that this feature of the invention is not disclosed or suggested by Ishida et al. For the same reasons given above, Hirano fails to cure the deficiency of Ishida et al.

Accordingly, for all of the reasons given *supra*, the combined teachings of Ishida et al. and Hirano do not present a *prima facie* case of obviousness. It is respectfully requested that the rejection of claims 1-9, 12-16 and 18-20 over Ishida et al. and Hirano be reconsidered and withdrawn.

**Rejection Under 35 U.S.C. § 103 over Ishida, Hirano and Ackermann**

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishida et al. (U.S. Patent No. 6,639,625), Hirano (U.S. Patent No. 5,740,472), and Ackermann et al. (U.S. Published Application No. 2001/0017665). The arguments of patentability set forth with respect to the rejection of Ishida et al. and Hirano *supra* are applicable to the present rejection and are incorporated herein by reference. Ackermann et al. does not cure the deficiencies of Ishida et al. and Hirano. Ackermann et al. discloses piezoelectric motors, but the motors are not seen to include an electromechanical conversion element which elongates and shrinks in response to vibration. More importantly, the reference fails to disclose or suggest using a detection circuit to detect whether the position of a particular driven member has or has not changed, let alone providing for a control circuit that sends a driving signal after a predetermined period of time to another driving unit drive the drive member of the particular driving unit. For all of the foregoing reasons, the combined teachings of Ishida et al., Hirano and Ackermann et al. do not present a *prima facie* case of obviousness. Accordingly it is respectfully requested that the rejection of claim 10 be reconsidered and withdrawn.

**Rejection Under 35 U.S.C. § 103 over Ishida, Hirano and Suzuki**

Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishida et al. (U.S. Patent No. 6,639,625), Hirano (U.S. Patent No. 5,740,472), and Suzuki et al. (U.S. Patent No. 6,269,580). The arguments of patentability set forth with respect to the rejection of Ishida et al. and Hirano *supra* are applicable to the present rejection and are incorporated herein by reference. Suzuki et al. does not cure the deficiencies of Ishida et al. and Hirano.

Suzuki is directed to a motor-driven focusing apparatus which includes a processing/control circuit 23 for controlling a single driven member. This circuit controls the focus state detecting system 20 and the focusing lens group driving system 30 to detect the focus state of the object image formed on a reference focal plane. While Suzuki teaches that the initial position of the focusing group is saved in RAM 24 after the start switch 27 is depressed and that a second position is again stored in RAM 24 if switch 27 is depressed again within 0.5 to 1 seconds (col. 6, lines 34-47), the focus state detecting system does not determine if the driven member is or has changed at a predetermined time. Even if it did, the reference does not disclose that the control circuit sends a driving signal to another driving unit after a predetermined period of time. Moreover, the data stored in RAM is erased if switch 27 is not pressed within 0.5 to 1 seconds (col. 6, lines 48-51). Thus, if the data is erased, the reference does not disclose or suggest that the focus state detecting system would be capable of determining whether the position of the drive member has or has not changed at a predetermined time as required that the independent claims. Also, Suzuki discloses controlling a single driven member as opposed to the claimed invention which requires controlling multiple driving members. In addition, Suzuki does not suggest or disclose that multiple driven members can be controlled to detect the position of each driven member and determine that the positions of the members has or has not changed.

The combined teachings of Ishida et al., Hirano and Suzuki et al. do not present a *prima facie* case of obviousness. Accordingly it is respectfully requested that the rejection of claim 11 be reconsidered and withdrawn.

**Rejection Under 35 U.S.C. § 103 over Ishida, Hirano and Emura**

Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishida et al. (U.S. Patent No. 6,639,625), Hirano (U.S. Patent No. 5,740,472), and Emura (U.S. Patent No. 5,768,038). The arguments of patentability set forth with respect to the rejection of Ishida et al. and Hirano *supra* are applicable to the present rejection and are incorporated herein by reference. Emura does not cure the deficiencies of Ishida et al. and Hirano. Emura is directed to a device employing piezoelectric vibrators. There is no disclosure or suggestion in Emura of using a detection control circuit to control drive members as set forth in the present claims. For these reasons, the combined teachings of Ishida et al., Hirano and Emura do not present a *prima facie* case of obviousness. It is respectfully requested that the rejection of claim 17 be reconsidered and withdrawn.

**Conclusion**

For the foregoing reasons, it is submitted that the claims 1-21 are patentable over the teachings of the prior art relied upon by the Examiner. Accordingly, favorable reconsideration of the claims is requested in light of the preceding amendments and remarks. Allowance of the claims is courteously solicited.

If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicant's attorney at the telephone number shown below.

A petition for a one-month extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. § 1.17 and due in connection with the

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filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT, WILL & EMERY

A handwritten signature in black ink, appearing to read "Cameron K. Weiffenbach". The signature is fluid and cursive, with a long horizontal stroke at the end.

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